



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,773	06/23/2003	Edward A. Youngs	020366-067210US	9495

20350 7590 09/11/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

STEIN, JULIE E

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,773	Applicant(s) YOUNGS ET AL.	
	Examiner Julie E. Stein, Esq.	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

3. In claim 30, the steps of determining whether the requested media program is presently being broadcasted and establishing a first wireless channel based upon the determination are both new matter. The Examiner can not find this subject matter within the originally filed application and Applicant did not indicate where the subject matter could be found in the most recently filed amendment.

4. In addition, in claim 40, the wherein clause contains the step of configuring the source provider in response to a request for a media program and determining whether the requested media program is presently being broadcasted, which is also new matter, as indicated above.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The Examiner notes that the rejection has been maintained and that any changes to the rejection are for clarification purposes and/or due to amendments to the claims.

6. Claims 30 to 49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,169,894 to McCormick et al.

McCormick discloses all the steps of independent claim 30, including a method for providing transmission of a selected media program to a plurality of wireless handsets deployed in a wireless network having at least one cell site coverage area associated therewith (Abstract and Figure 1), the method comprising:

receiving a request to receive a selected media program from a first wireless handset (Figure 3, steps 300 and column 6, lines 17 to 27);

determining whether the requested media program is presently being broadcasted on a wireless channel in the wireless network (Figure 3, step 310 and column 6, lines 30 to 50--the determining includes the correct and particular frequency, time slot or code of the requested information as described specifically in lines 36 to 47 and may be activated or deactivated, at any given time, as described in lines 49 to 50);

based upon said determination, establishing a first wireless channel upon which to broadcast the selected media program (Id.);

receiving a request to receive the same selected media program from a second wireless handset (inherent based on column 6, lines 59 to 66, as the reference

discloses that multiple users may use the same broadcast channel, therefore receiving a request is repeated multiple times); and

providing the selected media program to the second wireless handset (Id.).

The rejection of claim 30 is hereby incorporated. McCormick discloses all the elements of independent claim 40, including a system for providing transmission of a selected media program to a plurality of wireless handsets deployed in a wireless network having at least one cell site coverage area associated therewith (Abstract and Figure 1), the system comprising:

a source provider (Figure 3, local cell) configured to receive a transmission of a media program (column 3, lines 39 to 44) from at least one media program provider (inherent based on the media program information supplied in column 3, lines 39 to 44), the source provider (local cell) being further operative to simultaneously broadcast the selected media program (column 3, lines 39 to 44) to each of at least two wireless handsets (Figure 1) via a single wireless channel (column 5, lines 20 to 50); and

a wireless network configured to broadcast the selected media program from the source provider to the at least two wireless handsets (Figure 1);

wherein the source provider is further configured to, in response to a request for a requested media program, determine whether the requested media program is presently being broadcast on a wireless channel (Figure 3, steps 300 to 315--the determining includes the correct and particular frequency, time slot or code of the requested information as described specifically in lines 36 to 47 and may be activated or deactivated, at any given time, as described in lines 49 to 50) and, based upon said

determination, establish a wireless channel upon which to broadcast the selected media program (column 6, lines 33 to 35 and 51 to 54).

McCormick discloses all the steps/elements of dependent claims 31 and 47, including, wherein the selected media program comprises a selection from a group consisting of: a cable program, a television program, a satellite program, and a radio program (column 3, lines 39 to 44).

McCormick discloses all the steps/elements of dependent claims 32 and 45, including wherein the selected media program comprises a pre-recorded media program (Id.).

McCormick discloses all the steps/elements of dependent claims 33 and 46, including wherein the selected media program comprises a real-time transmission (Id.).

McCormick discloses all the steps/elements of dependent claims 34 and 48, including wherein the selected media program comprises a selection from a group consisting of: audio program (Id.), video program, and data transmission (Id.).

McCormick discloses all the steps of dependent claim 35, including wherein the second wireless handset and the first wireless handset are located in the same cell site coverage area (column 5, lines 20 to 40) and wherein providing the selected media program to the second wireless handset comprises providing the selected media program to the second wireless handset via the first wireless channel (Id.).

McCormick discloses all the steps of dependent claim 36, including, wherein the first wireless channel is comprised by a first cell site coverage area of the at least one cell site coverage area associated with the wireless network (Id. and Figure 1).

McCormick discloses all the steps of dependent claim 37, including where the second wireless handset is located outside the first cell site coverage area (Figure 1), the method further comprising:

establishing a second wireless channel upon which to broadcast the selected media program (column 5, lines 20 to 40).

McCormick discloses all the steps of dependent claim 38, including wherein the second wireless handset is located inside the first cell site coverage area (Figure 1), the method further comprising:

establishing a second wireless channel upon which to broadcast the selected media program (column 5, lines 20 to 40).

McCormick discloses all the steps/elements of dependent claims 39 and 42, including multiplexing (inherent in view of column 6, line 35) the media program onto the first and second wireless channels (column 5, lines 20 to 40).

McCormick discloses all the elements of dependent claim 41, including wherein the at least two wireless handsets include a first wireless handset and a second wireless handset (Figure 1) and wherein the source provider (local cell), in simultaneously broadcasting the requested media program, is further operative to simultaneously broadcast the requested media program to the first and second wireless handsets via first and second wireless channels (column 5, lines 20 to 40), respectively, wherein the second wireless channel is different from the first wireless channel (Id.).

McCormick discloses all the elements of dependent claim 43, including wherein the at least two wireless handsets include a first wireless handset and a second

wireless handset (Figure 1) and wherein the source provider (local cell), in simultaneously broadcasting the requested media program, is further operative to simultaneously broadcast the requested media program to both the first and second wireless handsets via a first wireless channel (column 5 lines 20 to 40).

McCormick discloses all the elements of dependent claim 44, wherein the source provider is the wireless network (local cell and Figure 1).

McCormick discloses all the elements of dependent claim 49, wherein the wireless network communication scheme comprises a selection from a group consisting of: TDMA, FDMA, and CDMA (column 6, line 35).

Response to Arguments

7. The rejection of claim 44 under 35 USC 112, first paragraph as been withdrawn.

8. In view of the amendment to claim 36, the rejection of claims 36 to 39 under 35 USC 112, second paragraph has been withdrawn.

9. Applicant's arguments filed July 5, 2006 have been fully considered but they are not persuasive.

10. The rejections of claims 30 to 49 under 35 USC 112, first paragraph as been maintained because the cited part of the original specification in support of claims 30 and 40 does not appear to actually support the claim recitations. The cited portions of the specification relate to the determination of a location of second wireless handset, as shown in Figure 3 and described on pages 5, line 21 to page 6, line 19, so that one of three methods of transmission of the requested media program can be used to transmit the media program to the second wireless handset. The Examiner still does not find

any support in the cited portion of the specification for the claim limitations of “determining whether the requested media program is presently being broadcasted on a wireless channel in the wireless network; and based upon said determination, establishing a first wireless channel upon which to broadcast the selected media program.”

11. As to the prior art rejection, Applicant argues that McCormick does not teach “determining whether the requested media program is presently being broadcasted on a wireless channel in the wireless network (and the variation in claim 40) nor does McCormick have any reason for such a determination because the information *is* being broadcast. The Examiner respectfully disagrees. In column 6, lines 36 to 50, McCormick discloses that the requested information is broadcasted, but also discloses that it may be activated or deactivated at any time (see Figure 5 and corresponding description) and therefore, there is a need to determine whether the information is being broadcasted.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JES



GEORGE ENG
SUPERVISORY PATENT EXAMINER